

Appendix "A"

Excerpts from Office Action

With regard to the 35 U.S.C. 103(a) rejections in §6 of the Office Action ("Comer in view of Miller"), the Examiner has argued:

"It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and Miller as both inventions relate to auto-completion of text inputs. Adding the teaching of Miller provides the benefit of the specific use of a pointing device to assist in user inputs."

(Page 5, lines 3-7, 22 ff.; page 6, lines 13-17; page 7, lines 3-6, etc.)

With regard to the 35 U.S.C. 103(a) rejections in §7 of the Office Action ("Comer in view of Miller and O'Hagen"), the Examiner has argued:

"It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and O'Hagen as both inventions relate to the input of partial characters. Adding the teaching of O'Hagen provides the benefit of dynamic refinement of choices."

(Page 18, lines 19 ff. to page 19, line 2)

With regard to the 35 U.S.C. 103(a) rejections in §8 of the Office Action ("Comer in view of Miller and Agulnick"), the Examiner has argued:

"It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and Agulnick as both inventions relate to pen-based computing. Adding the teaching of Agulnick provides the benefit of assuring that the user had chosen the right option."

(Page 19, lines 17-20)

"It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and Agulnick as both inventions relate to pen-based computing. Adding the teaching of Agulnick provides the benefit of processing a gesture."

(Page 20, lines 7-10)

With regard to the 35 U.S.C. 103(a) rejections in §9 of the Office Action ("Comer in view of Miller, O'Hagen and Agulnick"), the Examiner has argued:

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer, Miller, and Agulnick as all three inventions relate to pen-based computing. Adding the teaching of Agulnick provides the benefit of assuring that the user had chosen the right option.

(Page 21, lines 4-8; page 22, lines 4-8)

With regard to the 35 U.S.C. 103(a) rejections in §10 of the Office Action (“Comer in view of Miller and Forcier”), the Examiner has argued:

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and Forcier as both inventions relate to pen-based computing. Adding the teaching of Forcier provides the benefit of inserting space wrapping and moving forward any words that cross the right margin.

(Page 22, line 20 to page 23, line 2)

With regard to the 35 U.S.C. 103(a) rejections in §11 of the Office Action (“Comer in view of Miller and Niemeier”), the Examiner has argued:

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and Niemeier as both inventions relate to pen-based computing. Adding the teaching of Niemeier provides the benefit of detecting a keystroke on a touch-sensitive screen.

(Page 23, lines 10-13)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and Niemeier as both inventions relate to pen-based computing. Adding the teaching of Niemeier provides the benefit of using a virtual keyboard in an efficient manner.

(Page 24, lines 6-9)

With regard to the 35 U.S.C. 103(a) rejections in §12 of the Office Action (“Comer in view of Miller and Skinner”), the Examiner has argued:

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and Skinner as both inventions relate to pen-based [sic, computing]. Adding the teaching of Skinner provides the benefit of displaying and using a virtual keyboard.

(Page 24, lines 18-21; page 25, line 21 to page 26, line 3; etc.)

It would have been obvious to combine the teachings of Comer, Miller, and Skinner as all three inventions relate to character input. Adding the teaching of Skinner provides the benefit of displaying and using a virtual keyboard.

(Page 25, lines 12-15)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and Miller as both inventions relate to auto-completion of text inputs. Adding the teaching of Miller provides the benefit of the specific use of a pointing device to assist in user inputs.

(Page 31, lines 2-5; p. 34, lines 8-11)

With regard to the 35 U.S.C. 103(a) rejections in §13 of the Office Action (“Comer in view of Miller, Skinner and Lee”), the Examiner has argued:

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and Lee as both inventions relate to pen-based computing. Adding the teaching of Lee provides the benefit of more efficient use of screen space.

(Page 35, lines 4-7, 10-13, 19-22; p. 36, lines 3-6, 13-16, 19-22)

With regard to the 35 U.S.C. 103(a) rejections in §14 of the Office Action (“Comer in view of Miller, Skinner and LaGrange”), the Examiner has argued:

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and LaGrange as both inventions relate to pen-based computing. Adding the teaching of LaGrange provides the benefit of sensing the proximity of a pointing device to a touch-sensitive screen.

(Page 37, lines 17-20)

With regard to the 35 U.S.C. 103(a) rejections in §15 of the Office Action (“Comer in view of Miller, Skinner and Bi”),

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and Bi as both inventions relate to pen-based computing. Adding the teaching of Bi provides the benefit of a cursor that follows the movement of a stylus on a touch-sensitive screen.

(Page 38, lines 4-8; cf. p. 37, lines 16-18)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and Skinner as both inventions relate to pen-based computing. Adding the teaching of Skinner provides the benefit of placing a digital keyboard in a convenient location on a touch-sensitive screen.

(Page 39, lines 12-16)

With regard to the 35 U.S.C. 103(a) rejections in §16 of the Office Action (“Comer in view of Miller, Skinner, Bi and White”), the Examiner has argued:

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and White as both inventions relate to the input of characters. Adding the teaching of White provides the benefit of quickly relocating a cursor on a virtual keyboard so that the user can find it.

(Page 40, lines 4-7)

With regard to the 35 U.S.C. 103(a) rejections in §17 of the Office Action (“Comer in view of Miller, Skinner, Bi and LaGrange”), the Examiner has argued:

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Comer and LaGrange as both inventions relate to pen-based computing. Adding the teaching of LaGrange provides the benefit of sensing the proximity of a pointing device to a touch-sensitive screen.

(Page 39, lines 18-22)

REMARKS/ARGUMENTS

Claims 1-56, 83-85, 96-106, 130-133, 136-139 and 142-189 are pending.

Claims 1-5, 9, 14-21, 24, 30-32, 38-39, 46-53, 56, 84-85, 96-100, 105-106, 131, 133, 155-162, 164-165, 167-171 and 189 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comer et al. (U.S. Patent No. 5,845,300) in view of Miller (U.S. Patent No. 5,805,911).

Claims 10-13 have been amended. No new claims have been added. Claims 1-56, 83-85, 96-106, 130-133, 136-139, and 142-189 are thus pending. Claims 1, 47, 83, 84, 96, 155, and 189 are the independent claims.

§1. Pre-Appeal Conference

Applicant acknowledges the withdrawal of finality that occurred as the result of a Pre-Appeal conference filed 01/06/2006, as referred to in §§1 and 18 of the Office Action. In this regard, Applicant has responded below to the Examiner's specific comments in §18 of the Office Action.

§4. Informalities Objections

In §4, the Examiner has pointed out that Claims 10-12 all depend on Claim 12.

Claims 10-12 and 13 have been amended to depend on Claim 2 in accordance with the amendments submitted to the U.S. Patent and Trademark Office on July 9, 2004, which were apparently inadvertently omitted in the presently pending set of claims due to a clerical error. Accordingly, the objections to Claims 10-12 are overcome.

§§6-17. Summary of Art-Based Rejections Under 35 U.S.C. 103(a).

The following is a summary of the Examiner's art-based rejections:

1. In §6 of the Office Action, the Examiner has rejected Claims 1-5, 9, 14-21, 24, 30-32, 38-39, 46-53, 56, 84-85, 96-100, 105-106, 131, 133, 155-162, 164-165, 167-171, 173, 177 and 189 under 35 U.S.C. 103(a) as being unpatentable over Comer et al. (U.S. Patent No. 5,845,300, hereinafter "Comer") in view of Miller (U.S. Patent No. 5,805,911).

2. In §7 of the Office Action, the Examiner has rejected Claims 83 and 166 under 35 U.S.C. 103(a) as being unpatentable over Comer in view of Miller, and in further view of O'Hagen et al. (U.S. Patent No. 5,821,512, hereinafter "O'Hagen").
3. In §8 of the Office Action, the Examiner has rejected Claims 6, 8, 10-11, 130, 132, and 138-139 under 35 U.S.C. 103(a) as being unpatentable over Comer in view of Miller, and in further view of Agulnick et al. (U.S. Patent No. 5,347,295, hereinafter, "Agulnick").
4. In §9 of the Office Action, the Examiner has rejected Claims 136-137 under 35 U.S.C. 103(a) as being unpatentable over Comer in view of Miller, and in further view of O'Hagen, and in further view of Agulnick.
5. In §10 of the Office Action, the Examiner has rejected Claim 7 under 35 U.S.C. 103(a) as being unpatentable over comer in view of Miller, and in further view of Forcier (U.S. Patent No. 5,220,649, hereinafter "Forcier").
6. In §11 of the Office Action, the Examiner has rejected Claims 12-13, and 26 under 35 U.S.C. 103(a) as being unpatentable over Comer, in view of Miller, and in further view of Niemeier (U.S. Patent No. 5,574,482, hereinafter "Niemeier").
7. In §12 of the Office Action, the Examiner has rejected Claims 22-23, 25, 33-34, 54-55, 101-104, 142-145, 163, and 172-188 under 35 U.S.C. 103(a) as being unpatentable over Comer in view of Miller, and in further view of Skinner et al. (U.S. Patent No. 6,661,920, hereinafter, "Skinner").
8. In §13 of the Office Action, the Examiner has rejected Claims 27-29 under 34 U.S.C. 103(a) as being unpatentable over Comer in view of Miller, and in further view of Skinner, and in further view of Lee (U.S. Patent No. 6,292,179, hereinafter "Lee").
9. In §14 of the Office Action, the Examiner has rejected Claim 35 under 35 U.S.C. 103(a) as being unpatentable over Comer in view of Miller, and in further view of Skinner in further view of LaGrange et al. (U.S. Patent No. 5,914,708, hereinafter, "LaGrange").
10. In §15 of the Office Action, the Examiner has rejected Claims 36, 40-42, and 44-45 under 35 U.S.C. 103(a) as being unpatentable over Comer in view of Miller, and in further view of Skinner, and in further view of Bi et al. (U.S. Patent No. 6,262,719, hereinafter, "Bi").

11. In §16 of the Office Action, the Examiner has rejected Claim 37 under 35 U.S.C. 103(a) as being unpatentable over Comer in view of Miller, and in further view of Skinner, and in further view of Bi, and in further view of White et al. (U.S. Patent No. 5,982,351, hereinafter "White").
12. In §17 of the Office Action, the Examiner has rejected Claim 43 under 35 U.S.C. 103(a) as being unpatentable over Comer in view of Miller, and in further view of Skinner, and in further view of Bi and in further view of LaGrange.

Applicant traverses the Examiner's rejections below and reconsideration is respectfully requested.

The requirements for a *prima facie* case of obviousness have been well established. Three criteria must be met. First, the Examiner must identify prior art declaring all the salient elements recited in the Claims. Second, there must be some suggestion or, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Third, there must be a reasonable expectation that once combined the elements will work as expected. The teaching or suggestion to make the claimed combination, and the reasonable expectation of success, must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As will become apparent herein, it is submitted that all of the elements recited in the Claims are not taught or even suggested in the cited references. Additionally, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings.

Rejections Under 35 U.S.C. 103(a) of the Independent Claims

In §6 of the Office Action, the Examiner has rejected independent Claims 1, 47, 84, 96, 155, and 189 under 35 U.S.C. 103(a) as being unpatentable over Comer et al. (U.S. Patent No. 5,845,300) in view of Miller (U.S. Patent No. 5,805,911). In §7 of the Office Action, the Examiner has rejected Claim 83 under 35 U.S.C. 103(a) as being unpatentable over Comer in

view of Miller, and in further view of O'Hagen et al. (U.S. Patent No. 5,821,512). These rejections are now addressed.

The proposed combination of Comer and Miller clearly fails to satisfy the requirements for a *prima facie* case of obviousness for a number of reasons, as discussed below.

Independent Claim 1

Applicant's Claim 1 recites:

1. A method of processing text entered into a personal computing device with a pointing device, the method comprising:
 - (a) receiving a partial text entry comprising at least a first character;
 - (b) in response to receipt of the first character of the partial text entry, obtaining a dynamically generated list of completion candidates based on the partial text entry;
 - (c) displaying the list of completion candidates in a search list within a graphical user interface;
 - (d) receiving a user input signal associated with the pointing device;
 - (e) if the user input signal corresponds to a first type of user selection with the pointing device, deactivating the search list; and
 - (f) if the user input signal corresponds to a second type of user selection with the pointing device, replacing the partial text entry with a completion candidate from the search list.

The Examiner asserts that Comer discloses “(b) ... *obtaining a dynamically generated list of completion candidates based on the partial text entry*” (with the Examiner referring to column 2, lines 57-64 of Comer). The Examiner further argues the Comer discloses “(c) *displaying the list of completion candidates in a search list*” (with the Examiner referring to Figs. 3A-C of Comer). However, upon closer inspection it is clear that Comer fails, among other things, to disclose or suggest such elements as recited in Claim 1.

First, the Examiner makes the assertion that Comer discloses “*displaying the list of completion candidates in a search list*” based on the following argument: “(e.g., see Figs. 3A-C shows entering items into a spreadsheet executing within a graphical user interface)” (page 4,

lines 15-16 of Office Action). However, merely entering items into a spreadsheet by a user is clearly not equivalent to “displaying [a] list of completion candidates in a search list” as recited in Claim 1. The Examiner has not explained how user-entry of data into a spreadsheet is relevant to the claim limitation “*displaying the list of completion candidates in a search list*” as recited in Claim 1. For this reason alone, the Examiner’s rejection of Claim 1 is improper and should be withdrawn.

Furthermore, the Examiner’s interpretation is inconsistent with Comer’s disclosure of how Comer handles suggested completion lists. Significantly, at column 21, line 58 and following, Comer explains how his particular “suggested completion list” specifically relating to Figure 3 is built up. First, the Build Completion List routine gathers completed data items from associated spreadsheet cells. The list is then filtered in process block 314 to eliminate any surplus duplicated items. Finally, the filtered list of completed data items is sorted alphabetically in block 316. Comer then describes how the resulting completed data item list is used by the AutoComplete state 230 to provide completion suggestions to the user (column 22, lines 40 to column 23, line 6). Note that the resulting completed data item list (i.e., the “suggested completion list”) for Figure 3 is described in column 22, lines 30-38, as comprising: “Braves, Cardinals Dodgers, Giants, Mets, Padres, Phillies, and Reds”. However, Figure 3 fails to disclose, or even suggest, displaying this list. Instead, Comer illustrates displaying only a single suggested completion in Figs. 3B, 3C and 3H (i.e., “Braves” in cell 110), and only a single suggested completion in Fig. 3F (i.e., “Phillies” in cell 112).

Far from teaching displaying the entire “suggested completion suggestion list”, Comer instead clearly teaches displaying only one previously entered data item from the list, and that only if that data item uniquely matches the item being entered (column 10, lines 43-58). This is further reinforced by Comer from the following passages: the abstract; column 10, lines 59-67; column 11, lines 17-32; column 14, lines 31-42 and 52-67; column 15, lines 1-13; column 22, lines 51-65; Claim 13; Claim 23, Paragraph 7 of body; Claim 30, Paragraphs 2-4 of body; Claim 36, Paragraphs 2-4 of body. Nowhere does Comer disclose or suggest the possibility of displaying more than one suggested completion at a time to the user. Thus, Comer fails to

disclose or suggest displaying a “suggested completion list” in Figure 3. For these additional reasons, the Examiner’s rejection of Claim 1 is improper and should be withdrawn.

With regard to element (d) of Claim 1, the Examiner appears to make contradictory arguments. First, the Examiner argues that Comer teaches element (d), referring to Figures 3A-C (page 4, line 17 of the Office Action). However, the Examiner then apparently immediately reverses himself by arguing that Comer does not explicitly teach element (d) of Claim 1, although it is alleged that Miller teaches this limitation. Applicant assumes that the Examiner’s position is that Comer does not disclose element (d) of Claim 1, since the Examiner saw fit to rely on the Miller reference (U.S. Patent No. 5,805,911).

With regard to element (e) of Claim 1, the Examiner has conceded that Comer fails to teach “*(e) if the user input signal corresponds to a first type of user selection with a pointing device, deactivating the search list*” as recited in Claim 1. However, the Examiner alleges that Miller (U.S. Patent No. 5,805,911) teaches deactivating a search list in step 428 of Figure 4.

However, Figure 4 does not provide any disclosure or even suggestion of anything akin to a “search list” in Figure 4 of the Miller reference (U.S. Patent No. 5,805,911), much less anything like “deactivating the search list” or the other limitations of Claim 1. Figure 4 of the Miller reference merely illustrates multiple fields of entry for a computer application. Figure 4 is described in the following passages of the Miller reference relied upon by the Examiner:

“For example, the application can call a procedure in the forms package that causes a window or field of entry 35 to be created which prompts the user for text input as shown in Fig. 4”. (column 8, lines 24-26)

“When a user inputs text data, the forms package seeks a prediction from the multiple prediction modules through the prediction module manager 46. The prediction module manager 46 receives the results of the predictions from each prediction module and returns the best predictions to the forms package 36. As discussed in more detail below, the forms package 36 maintains a list that indicates the number of correct predictions received from each prediction module within the current field of entry, such as fields 1-10 illustrated in Fig. 4.” (column 9, lines 26-35)

“For example, referring to FIG. 4, if "JMILLER" is entered in the "RE:" field of a mailing program, and subsequently "JM" is entered in the "CC:" field of the same program, the attribute correlator will be able to predict "JMILLER" in the "CC:" field even though "JMILLER" has not previously been entered in the "CC:" field.” (column 11, lines 22-28)

“When the field of entry 35 (FIG. 4) is changed by a user, the new field of entry 35 moved into is recorded in the recent field use list 61.” (column 11, line 33)

None of the above passages disclose anything remotely resembling element (e) of Claim 1. Moreover, nowhere does the Miller reference refer to “step 428”, which was cited by the Examiner. While the Examiner has referred to Fig. 4 of the Miller reference numerous times throughout his Office Action in support of his rejections, Fig. 4 does not disclose anything that could be reasonably construed as supporting the Examiner’s assertions. It appears that the Examiner has incorrectly ascribed to the Miller reference features which it does not in fact disclose or suggest. Accordingly, the rejection of Claim 1 is not properly based on the prior art cited, and the rejection of Claim 1 is improper for this additional reason.

Finally, the Examiner argues that Comer teaches “*(f) if the user input signal corresponds to a second type of user selection with the pointing device, replacing the partial text entry with a completion candidate from the search list*”, as recited in applicant’s Claim 1. In this regard, the Examiner has referred to Comer, namely, step 428 of Figure 4 and column 5, lines 28-35.

However, applicant is unable to find any such disclosure in the Comer reference. Figure 4 of the Comer reference is a state flow diagram, and lacks any element 428. Element 428 does not even exist in Figure 4 of Comer. Furthermore, Column 5, lines 28-35 of the Comer reference briefly describes Figure 6 and 7A-B. None of the figures or text passages disclose anything similar to element (f) of Claim 1. It appears that the Examiner has ascribed features to Comer’s system which it does not have. Furthermore, if the Examiner meant to refer to the Miller reference cited by the Examiner in the Office Action (U.S. Patent No. 5,805,911), this reference also fails to disclose any such features apparently ascribed to it by the Examiner. Accordingly, the rejection of Claim 1 is improper for these additional reasons.

In view of the foregoing, applicant respectfully submits that the proposed combination of Comer in view of Miller fails to teach or suggest each and every limitation of Claim 1. Consequently, this combination of references fails to meet the legal requirements for a *prima facie* case of obviousness. Moreover, the rejection of Claim 1 is not properly based on the prior art cited as the Examiner has ascribed to the prior art features and paragraphs that do not even exist. For each of these reasons, the rejection of Claim 1 under 35 U.S.C. 103(a) is improper and should be withdrawn.

Applicant notes that throughout the Office Action the Examiner has also, in connection with many dependent claims, referred to *other* alleged portions of the Miller reference (U.S. Patent No. 5,805,911) which do not exist and do not support the Examiner's specific assertions and arguments. To the extent that this is the case, the Examiner has not provided a proper basis for his rejections of the claims on the basis of the Miller reference. The Examiner is therefore requested to withdraw all rejections which have improperly relied on Miller, or to explain, using correct citations, precisely *how* Miller is applicable.

Independent Claim 47

Claim 47 is a means language claim reciting a number of limitations similar to that recited in Claim 1, thus the rejection of Claim 47 under 35 U.S.C. 103(a) is improper for reasons including those provided above in respect of Claim 1.

Independent Claim 83

In §7 of the Office Action, the Examiner has rejected Claims 83 under 35 U.S.C. 103(a) as being unpatentable over Comer in view of Miller, and in further view of O'Hagen et al. (U.S. Patent No. 5,821,512). In making this rejection, the Examiner has expressly relied on his rationale for rejecting Claim 1 (page 18, line 6 of the Office Action) to also reject 83.

Claim 83 is a computer-readable medium claim having a number of limitations similar to those of Claim 1, including those relating to "*displaying the list of completion candidates in a search list*", a "*first type of user selection*", and a "*second type of user selection*", for example. Since the Examiner's proposed combination of Comer and Miller in respect of Claim 1 clearly fails to disclose or suggest these limitations, as discussed above, the rejection of

Claim 83 under 35 U.S.C. 103(a) is also improper for reasons including those provided above in respect of Claim 1.

In addition, Claim 83 recites “(g) *if the user input signal corresponds to a third type of user selection with the pointing device, dynamically obtaining a refined list of completion candidates based on one of the completion candidates from the search list, displaying the refined list of completion candidates in the search list for further user selection, and monitoring for a further user input signal associated with the pointing device.*” The Examiner has cited the O’Hagen reference, alleging that it discloses these limitations. Specifically, the Examiner has argued:

O’Hagen teaches that a virtual keyboard 280 may be used to input a product name by sequentially pressing areas of the screen 14 to spell out a product name. As the product name is spelled out, the typed letters will appear in block 281 and the scroll list will move to the products, which fit the partially typed description. After the customer has positioned the highlight bar 278 over the desired item, a virtual select button 282 is used to confirm the highlighted choice, the help find subroutine advances to step 504 where the location of the selected item is displayed to the customer (Col. 11, lines 66-67; Col. 12, lines 1-15). [page 18, lines 12-19 of the Office Action; emphasis added]

It appears that the Examiner has assumed that O’Hagen’s “scroll list” is analogous to the “search list” recited in Claim 83, and that O’Hagen’s list of product names in the “scroll list” are analogous to “completion candidates” as recited in Claim 83. Even if such an interpretation is adopted for the sake of argument, O’Hagen fails to disclose or suggest at least “*dynamically obtaining a refined list of completion candidates based on one of the completion candidates from the search list*” as recited in Claim 83. While the scroll list of O’Hagen system moves to list different products, it appears that this functionality is based on the partially typed description and not on a product name listed in the scroll list. Thus, O’Hagen fails to disclose or suggest element (g) of Claim 83 and the rejection based on O’Hagen is improper for this additional reason.

Independent Claim 84

Claim 84 is a system claim having a number of limitations similar to Claim 1, and thus the rejection of Claim 84 under 35 U.S.C. 103(a) is improper for reasons including those provided above in respect of Claim 1.

Independent Claim 96

Claim 96 is a method claim having a number of limitations similar to Claim 1, thus the rejection of Claim 96 under 35 U.S.C. 103(a) is improper for reasons including those provided above in respect of Claim 1.

In addition, it is noted that the Examiner rejected Claim 96 stating that the basis for the rejection is the “same rationale” as for Claims 1-2 (see page 15, line 1, of the Office Action). However, Claim 96 is different in certain respects when compared to Claim 2, and thus possesses different scope. For example, Claim 96 recites the limitation “...*to initiate further searching when a completion candidate in the search list remains selected for a predetermined time limit*”, whereas Claim 2 lacks such a limitation. The Examiner has ignored these differences with respect to Claim 96, and thus has not provided a proper basis for the rejection of Claim 96.

Independent Claim 155

Claim 155 is a system claim having a number of limitations similar to Claim 1. The Examiner rejected Claim 155 stating that the basis for the rejection is the “same rationale” as for Claim 1 (page 15, line 1 of the Office Action). Since the rejection of Claim 1 was improper, the rejection of Claim 155 under 35 U.S.C. 103(a) is improper for reasons including those provided above in respect of Claim 1 *mutatis mutandis*. For example, the cited art fails to disclose or suggest “*displaying the first plurality of completion candidates in a search list*” or “*obtaining a second plurality of completion candidates*”, or the combination of these elements, as recited in Claim 155.

Independent Claim 189

Claim 189 is a computer-readable medium claim having a number of limitations similar to Claim 1. The Examiner rejected Claim 189 using the “same rationale” as for Claim 1 (page 15, line 1 of the Office Action). Since the rejection of Claim 1 was improper, the rejection of Claim 189 under 35 U.S.C. 103(a) is improper for reasons including those provided above in respect of Claim 1 *mutatis mutandis*. For example, the cited art fails to disclose or suggest “*displaying the first plurality of completion candidates in a search list*” or “*obtaining a second plurality of completion candidates*”, or the combination of these elements, as recited in Claim 189.

Summary

In view of the above, each of the independent claims is allowable over the combinations of references proposed by the Examiner.

Rejections Under 35 U.S.C. 103(a): Dependent Claims

Claim 2 and 48

The Examiner has conceded that Comer fails to teach the limitations of Claim 2 and 48 (page 5, line 18 of the Office Action). However, the Examiner has alleged that Miller teaches these limitations in Figure 4 (page 5, line 22).

Figure 4 of the Miller reference has already been considered in detail with respect to Claim 1 above. Figure 4 fails to disclose or suggest anything like the limitations of Claims 2. For example, Figure 4 fails to disclose or suggest “*obtaining a refined list of completion candidates*” or “*displaying the refined list of completion candidates*”, as recited in Claim 2. Moreover, the Examiner has attributed to the Miller reference features which it does not disclose or suggest, and thereby has failed to provide a proper foundation for his rejection of Claim 2. Similar arguments are applicable to Claim 48 *mutatis mutandis*. Accordingly, the rejection of Claims 2 and 48 under 35 U.S.C. 103(a) is improper and should be withdrawn for each of these reasons.

In addition, Claims 2 and 48 depend from Claim 1 and 47, respectively, and therefore Claims 2 and 48 are allowable due to their dependencies, as well as due to the additional subject matter that they recite.

Claims 3-46, 105 and 130-131

Claims 3-46, 105, and 130-131 all depend directly or indirectly from Claim 1, and are therefore allowable due to their dependencies, as well as due to the additional subject matter that they recite.

Claims 49-56, 106, 132-133

Claims 49-56, 106, 132-133 depend from Claim 47, and are therefore allowable due to their dependencies, as well as due to the additional subject matter that they recite.

Claims 136-137

Claims 136-137 depend directly or indirectly from Claim 83, and are therefore allowable due to their dependencies, as well as due the additional subject matter that they recite.

Claims 85, 138-139

Claims 85, 138 and 139 depend directly or indirectly from Claim 84, and are therefore allowable due to their dependencies, as well as due to the additional subject matter that they recite.

Claims 97-104, 142-154, 185-188

Claims 97-104, 142-154, and 185-188 depend directly or indirectly from Claim 96, and are therefore allowable due to their dependencies, as well as due to the additional subject matter that they recite.

Claims 156-184

Claims 156-184 depend directly or indirectly from Claim 155, and are therefore allowable due to their dependencies, as well as due to the additional subject matter that they recite.

Other Improper Rejections

Notwithstanding the above arguments, applicant wishes to point out some additional errors and improper rejections in the Office Action.

The Examiner has rejected Claims 10 and 11 stating that the basis for the rejection is the “same rationale” as for Claim 6 (page 20, line 13 of Office Action). However, Claim 6 pertains to “*the second type of user selection*”, whereas Claims 10 and 11 pertain to “*the third type of user selection*”, therefore the Examiner has no basis for applying the allegedly “same rationale”. Accordingly, the Examiner has not provided a proper basis for the rejection of Claims 10 and 11.

The Examiner has rejected Claim 13 stating that the basis for the rejection is the “same rationale” as for Claims 6 and 8 (page 23, line 16 of the Office Action). However, while the Examiner purports to have rejected Claim 13 on the basis of Comer in view of Miller and Niemeier, Claims 6 and 8 were rejected by the Examiner based on a different combination of references. Therefore, the “same rationale” does not apply and the Examiner has failed to provide a proper rationale for rejecting Claim 13. In addition, Claim 13 pertains to the “*third type of user selection*” whereas Claims 6 and 8 pertain to the “*second type of user selection*”, therefore, the “same rationale” does not apply in any event, and the rejection of Claim 13 appears to be improper for this additional reason.

The Examiner has rejected Claim 31 stating that the basis for the rejection is the “same rationale” as for Claim 30 (page 12, line 21 of the Office Action). However, Claim 31 includes the limitation “*based on which of the dictionaries each particular completion candidate is retrieved from*” — a limitation that does not even exist in Claim 30. Therefore, the Examiner’s rationale for rejecting Claim 30 is insufficient to form a basis for rejecting Claim 31 and the rejection of Claim 31 is improper.

The Examiner has rejected Claim 166 stating that the basis for the rejection is the “same rationale” as for Claim 83 (page 19, line 5). However, the rationale applied in respect of Claim 83 is inapplicable to Claim 166 since the latter contains unique claim limitations, such as “*predetermined time limit*”, for example. Thus, the Examiner has not provided a proper basis for the rejection of Claim 166.

The Examiner has rejected Claim 104 stating that the basis for the rejection is the “same rationale” as for Claim 103 (page 29, line 15). However, Claim 104 recites the unique limitation “*displaying the search list while not displaying the digital keyboard and the graphical user interface in response to obtaining the second plurality of completion candidates*”, which is not present in Claim 103, and therefore cannot be rejected under the “same rationale”. Thus, the Examiner has failed to provide a proper basis for rejecting Claim 104.

The Examiner has rejected Claims 131 and 133 stating that the basis for the rejection is the “same rationale” as for Claim 104 (page 16, line 22). However, as noted above, the rejection of Claim 104 lacks a proper basis, and therefore the rejection of Claims 131 and 133 also lacks a proper basis. Thus, Claims 131 and 133 have been improperly rejected.

Similarly, the Examiner has rejected Claims 137, 139, 150 and 154 stating that the basis for the rejection is the “same rationale” as for Claim 104. As above, since the Examiner has failed to provide a proper basis for rejecting Claim 104, the aforesaid Claims also are improperly rejected. Furthermore, while the Examiner has purported to reject Claims 137 on the basis of Comer in view of Miller, O’Hagen and Agulnick, Claim 104 was rejected by the Examiner based on a different combination of references. Therefore, the rationale for rejecting Claim 104 (even if it was proper) would be inapplicable to Claim 137. Similarly, the Examiner purported to reject Claim 139 based on a combination of Comer in view of Miller and Agulnick, however, Claim 104 was rejected on a different basis. (See the Office Action at page 22, line 11; page 21, line 11; page 30, line 20; page 31, line 8.) Accordingly, the rejection of Claim 137 is also improper for this additional reason.

The Examiner has rejected Claim 173 stating that the basis for the rejection is the “same rationale” as for Claim 171 (page 17, line 18). However, Claim 173 recites “*means for obtaining a modified set of completion candidates*”, a limitation absent from Claim 171, therefore the rationale for Claim 171 is inapplicable in respect of Claim 173. Therefore, the Examiner has failed to provide a proper basis for the rejection of Claim 173.

The Examiner has rejected Claim 184 stating that the basis for the rejection is the “same rationale” as for Claim 175. However, when making his rejection of Claim 175 at page 32, line 21 to page 33, line 8, the Examiner appears to have completely ignored the following

limitation of Claim 175: “(c) means for displaying the search list while not displaying the digital keyboard in the graphical user interface in response to obtaining the second plurality of completion candidates”. Accordingly, the rejection of Claim 175 is improper and, consequently, the Examiner has also failed to provide a proper basis for the rejection of Claim 184. Thus, the rejection of Claim 184 is improper as well.

The Examiner has rejected Claims 158, 165 and 167 stating that the basis for the rejection is the “same rationale” as for Claims 84, 85, 96 and 155 (page 17, line 11 of the Office Action). The former Claims, however, contain subject matter that is distinct from the subject matter of the latter Claims. Therefore, the Examiner has failed to provide a proper basis for the rejection of Claim 158, 165 and 167.

No Proper Motivation or Suggestion to Combine

In addition to the issues raised above, in the Office Action, the Examiner has proposed the following combinations of references in making his rejections under 35 U.S.C. 103(a):

- A. Rejections in §6: Comer in view of Miller
- B. Rejections in §7: Comer in view of Miller and O’Hagen
- C. Rejections in §8: Comer in view of Miller and Agulnick
- D. Rejections in §9: Comer in view of Miller, O’Hagen and Agulnick
- E. Rejections in §10: Comer in view of Miller and Forcier
- F. Rejections in §11: Comer in view of Miller and Niemeier
- G. Rejections in §12: Comer in view of Miller and Skinner
- H. Rejections in §13: Comer in view of Miller, Skinner and Lee
- I. Rejections in §14: Comer in view of Miller, Skinner and LaGrange
- J. Rejections in §15: Comer in view of Miller, Skinner and Bi
- K. Rejections in §16: Comer in view of Miller, Skinner, Bi and White
- L. Rejections in §17: Comer in view of Miller, Skinner, Bi and LaGrange

In each of these rejections, the Examiner has asserted that it would have been obvious to combine the references cited by the Examiner in the manner cited. The specific assertions made by the Examiner in this regard are found in Appendix "A" attached hereto.

Legal Principles

Applicant submits that the rejections made based on the combinations above fail to provide a proper motivation or suggestion for combining and modifying the above sets of references. It will be noted that the applicable legal principles of the case law include the following (which are helpfully summarized in MPEP §§ 2143 and 2144):

1. The teaching or suggestion to make the claimed combination, and the reasonable expectation of success, must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).
2. If the rationale to modify or combine the prior art is not expressly or impliedly contained in the prior art, it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fe. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992).
3. However, as MPEP §2144.03 points out, when making allegations regarding the common knowledge of one of ordinary skill in the art or taking official notice, the examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *In re Soli*, 317 F.2d at 946, 37 USPQ at 801; *In re Chevenard*, 139 F.2d at 713, 60 USPQ at 241. It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. MPEP §2144.03(A).

4. If the proposed modification or would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).
5. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Examiner's Arguments

Applicant submits that in each of the rejections referred to above (§6-17) made under 35 U.S.C. 103(a), the Examiner has failed to provide a proper motivation or suggestion for combining and modifying the cited references. As the examples of the rejections quoted in attached Appendix "A" show, the Examiner's justification for combining references generally take the following rote form:

"It would have been obvious... to combine the teachings of [primary reference] and [secondary reference] as both inventions relate to [broad technical field]. Adding the teaching of [secondary reference] provides the benefit of [arbitrary feature of secondary reference]."

However, such an approach to obviousness rejections is inconsistent with the legal rationale for why the Examiner must provide some specific teaching, suggestion, or motivation upon which to base combining references. This rationale was quoted in *Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339, 56 USPQ2d 1641 (Fed. Cir. 2000), from *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (internal citations omitted):

As this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner [or accused infringer] may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the

claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability” [...] To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. [emphasis added]

In the present case, the Examiner has failed to point to a teaching or suggestion in the prior art itself, to modify or combine the references as proposed by the Examiner. For example, the Examiner has justified the combination of the teachings of Comer and Agulnick on the basis that both inventions “relate to pen-based computing”. Even if both references *did* relate to pen-based computing, this does not amount to a motivation or suggestion to combine the references. What is needed is a specific teaching in the prior art that would indicate the desirability of the proposed combination. Merely identifying that references generally relate to a broad technical field falls far short of the legal requirement to provide a specific motivation or suggestion to combine the references.

For example, the Examiner has used “relat[ing] to pen-based computing” as a reason for combining the teachings of Comer, Miller, and Agulnick, combining the teachings of Comer and Forcier, combining the teachings of Comer and Niemeier, combining the teachings of Comer and Skinner, combining the teachings of Comer and Lee, combining the teachings of Comer and LaGrange, and combining the teachings of Comer and Bi.

If the Examiner *was* correct that merely to be related to pen-based computing was a sufficient motivation or suggestion to combine references, then hardly any patents would be allowable in the field of pen-based computing, since the Patent Office could always find any given combination of elements by building a mosaic of disparate prior art references from the field of pen-based computing, and then could issue obviousness rejections on that basis, as the Examiner has done in this case.

The same problem is apparent in the Examiner’s other alleged “motivations” to combine references by means of allusions to broad technical fields (e.g., “both inventions relate to auto-completion of text inputs”, “both inventions relate to the input of partial characters”, “all three inventions relate to character input”, “both inventions relate to the input of characters”). It should be apparent that if merely identifying that two references relate to a broad technical field

was sufficient justification for combining references, the requirement to find a motivation or suggestion to combine references in the prior art itself would be meaningless.

In addition, a number of the Examiner's "field-based" arguments are factually incorrect. In particular, Comer does not relate to "pen-based computing". Comer only refers to "pens" *in passing* as an example of a mouse-alternative which can be used for positioning a cursor on a computer monitor (column 7, lines 49-51). Comer does not refer to pens at any other point of what is a detailed and lengthy disclosure. *One* passing reference to "pens" hardly qualifies a reference as being "related to pen-based computing". Accordingly, Applicant submits that the Examiner should withdraw all of his rejections based on reference combinations rationalized by the Examiner's "pen-based computing" argument.

The Examiner has also tried to justify his proposed combinations of references by claiming that adding a particular feature from the reference-to-be-combined to the primary reference is advantageous, but has not presented a clear line of reasoning, based on either the prior art or on the common knowledge of one of ordinary skill in the art, to show why this is in fact the case.

For example, with respect to the combination of Comer and Agulnick, the Examiner has argued that "adding the teaching of Agulnick provides the benefit of assuring that the user had chosen the right option." This assertion is ambiguous. *What* is the "right option" referred to by the Examiner? *How* does Agulnick ensure that the user has chosen the right option? Agulnick makes no mention of choosing the "right option", and therefore it is entirely unclear what the Examiner had in mind. The Examiner has also argued that "adding the teaching of Agulnick provides the benefit of processing a gesture." But *how* is processing a gesture beneficial according to Agulnick? In what *way* would the gesture be processed according to Agulnick? How does this feature *fit* with the system disclosed by Comer? The Examiner has not explained. Accordingly, the Examiner's arguments for combining Comer and Agulnick are improper and should be withdrawn.

With respect to the combination of Comer and Forcier, the Examiner has argued that "adding the teaching of Forcier provides the benefit of inserting space wrapping and moving forward any words that cross the right margin", but has not explained why such a feature would

be advantageous according to the prior art if combined with the teaching of the Comer reference, or how such a feature would work if combined with the teaching of the Comer reference. Comer does not appear to mention anything about a need for “space wrapping”, and it is not apparent why it would be advantageous.

Similarly, with respect to the combination of Comer and Bi, the Examiner has argued that “adding the teaching of Bi provides the benefit of a cursor that follows the movement of a stylus on a touch-sensitive screen.” However, the Examiner has not explained, with reference to the Comer system, *why* this would be a benefit or how it would work in the alleged combination.

With respect to the combination of Comer and LaGrange, the Examiner has argued that “adding the teaching of LaGrange provides the benefit of sensing the proximity of a pointing device to a touch-sensitive screen”. It does not appear that the LaGrange reference teaches how to sense the proximity of a pointing device. But even if LaGrange did teach such a method, it is also not apparent, and the Examiner has not explained, *how* the system described by Comer would benefit from sensing the proximity of a pointing device. The Comer system does not appear to be in need of such a feature. Moreover, the LaGrange system appears to depend for its operation on detecting a disturbance in a capacitance-sensitive touch pad. To achieve the sensing effect envisioned by the Examiner, it would presumably be necessary to place the touch pad *over* the monitor 31 of the Comer system. However, this would appear to interfere with viewing the monitor 31, and thus render Comer’s system inoperable. Thus, the proposed combination is non-obvious.

With respect to the combination of Comer and references such as Niemeier, Skinner, Lee, the Examiner has alleged benefits from adding a virtual or digital keyboard to the Comer system. However, Comer is primarily concerned with improving the speed and integrity of data entry into spreadsheets and databases, and thus it appears to be presumed by Comer that the primary mode of character input will be an ordinary keyboard. To intersperse stylus usage with keyboard usage during data entry would slow down the user, and would thus appear to be disadvantageous to Comer.

In summary, the Examiner has failed to provide an explanation or a line of reasoning, for the proposed combinations of references relied upon as a basis for rejections in the Office Action. The Examiner's alleged "advantages" of combining references are far from clear, and, are not grounded in the teachings of the prior art itself, nor in the common knowledge of one of ordinary skill in the art (as substantiated by prior art evidence). Applicant submits that the Examiner has not provided a proper rationale for the proposed combination of references, and therefore the rejections under 35 U.S.C. 103(a) based on each of these proposed combinations should be withdrawn for these additional reasons.

§18. Applicant's Arguments in Request for Pre-Appeal Conference

Applicant acknowledges the Examiner's indication that Applicant's arguments in the Request for Pre-Appeal Conference, filed 12/14/2005, have been fully considered and are persuasive, such that the previous rejections have been withdrawn. However, in his comments in §18, the Examiner appears to give the impression that the primary issue before the Pre-Appeal Conference was that the previously cited references – U.S. Patent No. 5,896,321 ("Miller et al.") and U.S. Patent No. 6,377,965 ("Hachamovitch et al.") – merely failed to teach the limitation "*(a) receiving a partial text entry comprising at least a first character*".

Applicant disagrees. An examination of the record clearly shows that Applicant argued that the Examiner had improperly rejected Applicants' Claim 1 on the ground that its language "allow[ed] for the possibility of more than a single character invoking a response". The Examiner's argument regarding the breadth of Claim 1 clearly contradicted element (b) of Claim 1, effectively removing from Claim 1 the specific language "in response to... the first character", recited in element (b). In addition, Applicant argued that *not only* do U.S. Patent Nos. 5,896,321 and 6,377,965 fail to disclose or suggest the method recited in Claim 1, but, as set forth in applicant's previous submissions, both these references expressly teach away from the applicant's method in Claim 1. Both U.S. Patent Nos. 5,896,321 and 6,377,965 expressly teach that it is at best *useless*, and at worst *counterproductive* (e.g., "annoying"), to provide word predictions based on a single character. Applicants' Claim 1 recites language covering precisely

what these two references taught was *undesirable*, thus the claim could not be considered obvious in view of these references.

Applicant takes this opportunity to point out that it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731,743,218 USPQ 769,779 (Fed.Cir.1983): MPEP §2145.X(D)(2). Thus, it would be improper to combine a reference which teaches that it is undesirable to produce word predictions based on a single character, with a reference which does so, because the former reference “teaches away” from the combination.

CONCLUSION

In view of the foregoing and the marginal relevance of the prior art found thus far despite multiple searches, Applicant believes that all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Applicant herewith petitions for an automatic extension of time of 3 months, from June 20, 2006 to September 20, 2006, for responding to the outstanding Office Action dated March 20, 2006.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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